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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,026	06/30/2003	Alan M. Zamore	2003-5	7377
23401	7590	03/17/2005	EXAMINER	
ALAN M ZAMORE 23 MOUNTAIN AVE MONSEY, NY 10952			SERGEANT, RABON A	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,026

Applicant(s)

ZAMORE, ALAN M.

Examiner

Rabon Sergent

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-24 and 26-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's election of the species, copoly(ether-ester-amide), within the response of January 3, 2005 is acknowledged. Accordingly, claims 1-11 and 25 have been withdrawn from further consideration, as being drawn to a non-elected invention. Furthermore, claims 12-24 and 26-33 have been examined with respect to the elected species.
2. It is requested that applicant amend the "Cross Reference to Related Application" section of the specification to reflect the status of serial number 08/947,000.
3. Claims 23, 24, 32, and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, with respect to component (b) of claims 23 and 24, it is unclear what purpose is served by the language, allylic monomers, since the compounds have been identified by name. Furthermore, if the aforementioned language is deleted, then the species should not be recited in the alternative.

Secondly, within line 7 of claim 24, the language, "the radiation crosslinkable composition", lacks antecedent basis.

Thirdly, within line 3 of claim 32, the language, "said cross-linked composition", lacks antecedent basis.

Lastly, within line 33 of claim 32, the language, "the medical device", lacks antecedent basis.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 12-24 and 26-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-13 and 20-36 of U.S. Patent No. 6,596,818. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims is drawn to a composition or article comprising a radiation crosslinkable or crosslinked composition comprising copoly(ether-ester-amide) and a monomer crosslinker. The position is taken that acrylate and methacrylate crosslinking monomers, due to their similar structure, are obvious variants of each other, and that one is suggestive of the other.

6. Claims 12-24 and 26-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 24 of copending Application No. 10/688,292. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because the instant claims drawn to an angioplasty balloon or composition or article, each comprising a crosslinked or crosslinkable copoly(ether-ester-amide) are obvious variants of the catheter balloon comprising radiation crosslinked polyamide/polyether polyester of claim 24 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 26, 28, 29, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. ('316).

Patentees disclose a photosensitive resin composition comprising a thermoplastic elastomer, such as a polyamide-imide ester derived from a polyoxyalkylene glycol, and an unsaturated compound, such as an acrylate, methacrylate, or allylic compound. See abstract; column 2, lines 40+; column 3, lines 16+; and column 8, lines 41-57. The position is taken that patentees' thermoplastic elastomer meets applicant's copoly(ether-ester-amide) polymer and that the disclosure at column 13, lines 10+ is sufficient to satisfy the requirements of claims 28 and 31. Furthermore, applicant's claimed increased tolerances are inherent features of the disclosed compositions.


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9. Claims 23, 24, and 26-31 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Neil et al. ('551 or '415).

Patentees disclose the conversion of a thermoplastic copoly(ether-ester-amide) to a thermoset or crosslinked product by incorporating triallylcyanurate or triallylisocyanurate into the thermoplastic and subsequently exposing the resulting composition to irradiation. See abstract and columns 3 and 4. Patentees further disclose that the compositions may be used in the medical field or as insulation in the wire and cable industry. See column 4, lines 49+. The position is taken that applicant's claimed increased tolerances are inherent features of the composition and that the disclosed medical applications inherently encompass sterilization procedures or features.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
March 14, 2005


RABON SERGENT
PRIMARY EXAMINER